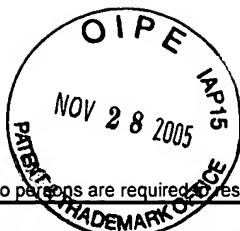


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

224694

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on November 22, 2005Signature Mary A. SmithTyped or printed name Mary A. Smith

Application Number

10/701,098

Filed

November 3, 2003

First Named Inventor

Julie Anne Loeger

Art Unit

3624

Examiner

Lalita M. Hamilton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 45,177☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

SignatureVladan M. Vasiljevic

Typed or printed name

(312) 616-5600

Telephone number

November 22, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Attorney Docket No. 224694

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

LOEGER et al.

Art Unit: 3624

Application No. 10/701,098

Examiner: Lalita M. Hamilton

Filed: November 3, 2003

For: AWARD SYSTEM WITH
INCREASED PAYOUT OPTIONS

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Office action dated August 11, 2005 rejected all of the claims of the present application, namely claims 1-29, under 35 U.S.C. §103(a) as anticipated by U.S. Patent Application Publication No. 2003/0061093 to Todd ("Todd") in combination with U.S. Patent No. 6,786,400 to Bucci ("Bucci"). This obviousness rejection is not proper. As an initial matter, the proposed combination is defended, not on what the primary reference teaches, but rather on what it does *not* teach. Additionally, the pertinent section of the Office action -- a mere three sentences -- presents conclusory statements that are not sufficient in view of the Federal Circuit's requirement that "[t]he factual inquiry whether to combine references must be thorough and searching." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Finally, there is simply no suggestion in either of the two references to make the proposed combination. The primary reference merely hints at the use of a specialized routing system, while the secondary reference, which is not even directed to the same subject matter as the primary reference, teaches nothing more than a conventional routing system used in the normal and expected manner.

A Reference's Silence Cannot Support A Motivation To Combine

The primary reference, Todd, contains no teaching or disclosure regarding the mechanism by which an accumulated award is transferred from one user to another. *See e.g.*, Todd, at ¶ [0080] (describing the transfer only as a debit to the transferor account and a credit to the transferee account.) During a telephonic interview on September 2, 2005, for which the applicants and their representative extend their thanks, Examiner Hamilton agreed that the Todd reference was silent as to the award transfer mechanism. According to the Examiner, this meant that its disclosure was sufficiently broad to support any number of potential mechanisms, including the mechanism described by Bucci.

A reference's silence is not equivalent to a broad disclosure. By not specifying any particular mechanism by which awards can be transferred from one account to another, Todd cannot be said to suggest the use of *all* mechanisms by which awards can be transferred. Instead, the disclosure of Todd, at most, only teaches the use of those mechanisms by which such awards would traditionally be transferred. Bucci, however, does not disclose any such mechanisms. There is no mention, or even a suggestion, of an award system anywhere in Bucci. Thus, the only use of the transfer mechanisms that are mentioned in Bucci, such as the ABA routing mechanisms, is their traditional use of transferring money to or from a bank account. *See Bucci* at col. 4, lines 5-30 (specifying a myriad of account types, but specifically excluding award accounts.) Absent a teaching that awards are to be treated in the same manner as more general funds for purposes of transferring them from one account to another -- *a teaching provided only by applicants' disclosure* -- the ABA routing system of Bucci cannot be combined with the award transfers of Todd.

A Single Conclusory Statement Does Not Establish A *Prima Facie* Case Of Obviousness

The *entire* Office action, when the boilerplate language is excluded, comprises a single three sentence paragraph. The first sentence states that the primary reference lacks a claim element. The second sentence states that the missing element is disclosed in the secondary reference. The third sentence merely concludes that it would have been obvious to combine the two “to provide the user with a means of transferring awards/funds between accounts located at various institutions.” Office action dated August 11, 2005, page 3.

Even assuming that Todd does suggest the “transferring of awards ... between accounts located at various institutions,” which it does not¹, there is nothing in this one sentence that states why one of skill in the art would use the disclosed transfer mechanism in this hitherto unheard of way. The present Office action provides nothing more than the Office action found lacking by the Federal Circuit in Lee. See id., 277 F.3d at 1434 (criticizing as insufficient an examiner’s conclusory statement that a combination of cited references would be obvious.)

The Proposed Combination Is Counter To The Purpose Of The Primary Reference

The primary reference is directed to an award system that facilitates transfers *only* among other award accounts maintained by the same financial services provider. See id. at ¶ [0012] (“[a]nother object of the invention is to provide ... a means for one user of the services to transfer value for the direct benefit *of another one of the users*”) (emphasis added). By limiting the reward system to provide only for intra-system transfers, Todd seeks to benefit the financial institution

¹ Todd does disclose the transferring of “funds” between accounts located at various institutions, but to lump “awards” together with “funds” defeats the basic purpose to which the invention of Todd is directed, and ignores the prior art in general which, up until applicant’s invention, did not enable award values to be transferred in the same way as ordinary funds. See pages 3-4, *infra*.

granting the awards and maintaining the award accounts. In fact, “the primary advantage of the system or network is the capacity to accumulate value on behalf of multiple users, without setting up and administering multiple individual savings or investment accounts. Instead, the aggregate accumulated value of all accounts ... can be supported by *a single investment account* administered by the financial services provider.” *Id.* at ¶ [0086] (emphasis added). In addition to providing a benefit to the financial institution granting the awards, by limiting the transferability of the award only among other reward accounts, Todd also seeks to provide a benefit to “users who are disinclined to save.” *See e.g. id.* at ¶ [0085]. Indeed, the first listed “object of the ... invention” of Todd is “to provide a system ... that promotes savings...” *Id.* at ¶ [0011].

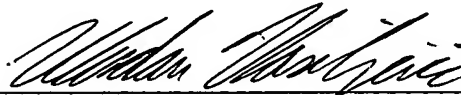
Were the awards of Todd as freely transferable as cash through a universal routing system, such as the ABA routing system used by Bucci, the benefits sought to be conferred by the invention of Todd would be nullified. The financial institution would not receive the efficiency benefits promised by Todd, since it would need to maintain individual award accounts as each account would be independently accessible through its unique ABA routing information. Similarly, users who are “disinclined” to save would likewise not receive the intended benefits of the Todd invention since such users would be able to spend their award as easily as the cash in their bank account. *See id.* at ¶ [0005] (“[s]ome individuals are unable to save, while others ... lack the willpower to do so. In either event, the penalty ... can be harsh.”)

A proposed combination that eviscerates the clearly stated purposes and goals of the primary reference rarely establishes a *prima facie* case of obviousness. *See e.g., In re Rouffet*, 149 F.3d 1350, 1356 (Fed. Cir. 1998).

Conclusion

The combination proposed by the Office action dated August 11, 2005 fails to make out a *prima facie* case of obviousness. The Office action presents only a single conclusory statement to support the combination, the primary reference's silence as to the transfer mechanism is improperly relied upon, and the proposed combination directly violates the goal of the primary reference. In the end, the applicants are the only ones who have described a mechanism by which a standard routing system, traditionally used by financial institutions to transfer funds, is now also used to transfer awards. Consequently, allowance of the claims presented by Amendment A, filed on May 19, 2005, is respectfully requested.

Respectfully submitted,



Vladan M. Vasiljevic, Reg. No. 45,177
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: November 22, 2005